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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,359	03/01/2004	Caleb C. Rutan	INST-P01	9337
49142	7590	11/28/2008	EXAMINER	
SCHOX PLC 730 Florida Street #2 San Francisco, CA 94110				WEST, THOMAS C
ART UNIT		PAPER NUMBER		
		3685		
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		11/28/2008		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/790,359	RUTAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	THOMAS WEST	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 July 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) See Continuation Sheet is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 7, 8, 12, 13, 16, 20, 22, 23, 26, 27, 30, 34, 35, 38, 41, 47, 48, 49, 52, 55 58-67 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims pending in the application are 1,7,8,12,13,16,20,22,23,26,27,30,34,35,38,41,47-49,52,55 and 58-67.

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the Arguments/Remarks filed 7-25-08.
2. Claims 1, 7, 8, 12, 13, 16, 20, 22, 23, 26, 27, 30, 34, 35, 38, 41, 47, 48, 49, 52, 55, 58-67 are currently pending and have been examined.

### ***Response to Arguments***

5. Applicant's arguments filed 7-25-08 have been fully considered but they are not persuasive. Applicant's arguments will be addressed in sequential order as they were set forth in the "Remarks" section on the above date. Applicant argues that Inoue does not disclose "the first set of licensed actions is less restrictive than the initial set of permissible actions". Inoue discloses, "The management server 5 is a computer system that manages usage license of contents and their distribution. In response to a ticket request, the management server 5 judges whether the ticket request is made by the child terminal 7. If not, the management server 5 issues, to the terminal making the request, a license ticket that enables playback of the requested content under certain usage rules (less restrictive). When judging that the request is made by the child terminal 7, the management server 5 attaches additional usage rules (more restrictive), which are provided in advance according to a request from the parent terminal 6, to a usage range so as to produce a new license ticket for the child terminal 7, and issues it to the requesting terminal" paragraph 45. Inoue further discloses, "That is to say, the

ticket producing unit 54 obtains usage restrictions from the parental control unit 56 and adds (more restrictive) the obtained usage restrictions to the usage rules requested in the ticket request to produce usage rules for the child user. The ticket producing unit 54 then attaches a content key to the produced child usage rules, and writes the user ID of the child terminal 7 to produce a license ticket for the child user”, paragraph 51. This further answers both the applicant’s argument that the parent/child relationship is not a set/subset and Inoue fails to teach modifying the first license. Here Inoue is clear that the child usage rules are in addition to parental usage rules and are a modification of parental rules. Inoue further teaches transferring from the first client to the second client, “The parent terminal 6 also relays data to/from the child terminal 7 by transferring the content request and the ticket request from the child terminal 7 to the management server 5 and transferring the requested content and the child license ticket from the management server 5 to the child terminal 7” paragraph 58. Applicant argues that Barber does not teach a dummy file (empty file). Barber discloses, “The license 27 so transferred is referred to as a "transferred license". In step 48, the license manager 25A causes the license 27 to be stored in the system memory 16 at the local node 14. The license manager 25A then takes path 49 to a step 50 that causes the operating system 15 at the local node 14 to create a new empty license file 22A on the local node 14 at which it is desired to use the copy of the computer program 24A” col. 11, lines 1-9.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 66, 67 recite “upon user request”, which lacks support in the specification.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 7, 8, 12, 20, 22, 23, 26, 27, 30, 34, 38, 41, 47, 48, 52, 55, 58-67 are rejected under U.S.C. 102(b) as being unpatentable over Inoue, U.S. Patent Application No. 2003/0028622.

**Claims 1, 7, 26, 27, 41, 47, 58-67:**

Inoue, as shown, discloses the following limitations:

- requesting the electronic file, transferring the electronic file to the first client, and allowing an initial set of permissible actions with the electronic file regardless of a connection between the first client and the server (see at least paragraphs 6, 45, 51) ;
- requesting a license from the server, transferring a first license to the first client, and allowing a first set of licensed actions with the electronic file based on the first license, wherein the first set of licensed actions is less restrictive than the initial set of permissible actions (see at least paragraphs 6, 45, 51)
- upon the occurrence of an event, requesting a license from the server and modifying the first license (see at least paragraph 58)
- allowing an initial set of permissible actions with the electronic file regardless of a connection between the first client and the server, wherein the first set of licensed actions is less restrictive than the initial set of permissible actions (see at least paragraphs 45, 51, 117)
- transferring a second license to the second client that allows a second set of licensed actions with the electronic file (see at least paragraph 58)
- modifying the first license includes updating a license for a purchase/complaint (see at least paragraphs 37, 76, 105).
- modifying the first license includes revoking the license of the first client (see at least paragraph 106).
- transferring the electronic file to the first client (see at least paragraph 6, 45, 51)

- deleting the electronic file from the first client (see at least paragraph 106).
- modifying the first license includes revoking the license of the first client upon user request (see at least paragraph 106).
- opening/printing the electronic file on the second client (see at least paragraph 80, 116)
- modifying the first license includes revoking the license of the first client upon user request to enable the transfer of a second license to the second client (see at least paragraph 106)
- modifying the first license includes revoking the license of the first client upon user request to enable the creation of a second license for the second client (see at least paragraph 106).

**Claims 12, 22, 48:**

Inoue, as shown, discloses the following limitations:

- allowing a first/modified set of licensed actions regardless of a connection between the first client and the server (see at least paragraphs 6, 45, 51, 115)

**Claims 20, 34, 52, 55:**

Inoue, as shown, discloses the following limitations:

- further includes transferring a modified license to the first client and, upon receipt of the modified license from the server, allowing a modified set of

licensed actions with the electronic file wherein the modified set of licensed actions is more restrictive than the first set of licensed actions (see at least paragraphs 4, 115)

**Claims 8, 23, 30, 38:**

Inoue, as shown, discloses the following limitations:

- receiving a license request from the second client and transferring a second license to the second client that allows a second set of licensed actions with the electronic file, and generating a second license based on an attribute of the second client, wherein the second set of licensed actions is substantially similar to the first set of licensed actions. (see at least paragraphs 38, 115)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13, 16, 35, 49 are rejected under U.S.C. 103(a) as being unpatentable over Inoue, U.S. Patent Application No. 2003/0028622 in view of Barber, US Patent No. 5,390,297.

**Claims 13, 16, 35, 49:**

Inoue discloses the limitations as shown above. Inoue does not directly disclose a dummy file or empty license, but Barber teaches:

- the event is a transfer of the file from the first client to the second client, requesting a dummy file upon the transfer of the file from the first client to the second client, and receiving the dummy file and requesting a license from the server upon the receipt of the dummy file. (see at least column 10, lines 29-68, column 11, lines 1-28)
- receiving an empty license from the server and, based on the empty license, allowing an initial set of permissible actions with the electronic file, and allowing an initial set of permissible actions regardless of a connection between the first client and the server, wherein the initial set of permissible actions is more restrictive than the first set of licensed actions (see at least column 10, lines 29-68, column 11, lines 1-28)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Inoue to include the dummy file and empty license of Barber, since this aids in insuring the erasure/deletion of the original license file, preserving the security of issued licenses.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on M-R 7:30am - 5pm EST, ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West  
Patent Examiner  
Art Unit 3685  
November 23, 2008

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685